REMARKS

Applicant respectfully requests reconsideration of this application in view of the following remarks. Claims 1, 2, 4-7, 11, 12, 16-21 and 26 have been amended. Claims 1, 2, 4-7, 9-12, and 14-30 are pending. Antecedent basis for the amendments is located throughout Applicant's specification and the original claims, as for example in connection with the discussion of Figs. 1, 3b, 3l-3q, 4, 6 and 7a-7d. No new matter has been added.

Substitute Title

Applicant respectfully asks the Examiner to formally accept the substitute title.

Rejection of the claims

The Office Action rejected claims 1, 6 and 11 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,643,663 ("Dabney") in view of U.S. Patent No. 6,401,075 ("Mason").

As amended, claim 1 recites:

> 1. A method performed by a computer system, comprising:
> storing a version of a hardcopy paper, the version being displayable on a display device as a likeness of the paper;
> in response to content of the likeness, detecting a reference at a first location within the content of the likeness, the detected reference being associated with a second location, and wherein the detected reference is at least one of the following, other than a computer network address: an alphanumeric character; a symbol; a term; and a phrase; and
> in response to the detected reference, embedding a hyperlink within the version between the first location and the second location, and the first location being: displayable on the display device as part of the likeness; highlighted to indicate the hyperlink; and selectable by a user to cause an operation associated with the second location.

As amended, claim 6 recites:

> 6. A system, comprising:
> a computing device for:
> storing a version of a hardcopy paper, the version being displayable on a display device as a likeness of the paper;
> in response to content of the likeness, detecting a reference at a first location within the content of the likeness, the detected reference being associated with a second location, and wherein the detected reference is at least one of the following, other than a computer network address: an alphanumeric character; a symbol; a term; and a phrase; and
> in response to the detected reference, embedding a hyperlink within the version between the first location and the second location, and the first location being: displayable on the display device as part of the likeness; highlighted to indicate the hyperlink; and selectable by a user to cause an operation associated with the second location.

As amended, claim 11 recites:

> 11. A computer program product, comprising:
> a computer program processable by a computer system for causing the computer system to:
> store a version of a hardcopy paper, the version being displayable on a display device as a likeness of the paper;
> in response to content of the likeness, detect a reference at a first location within the content of the likeness, the detected reference being associated with a second location, and wherein the detected reference is at least one of the following, other than a computer network address: an alphanumeric character; a symbol; a term; and a phrase; and
> in response to the detected reference, embed a hyperlink within the version between the first location and the second location, and the first location being: displayable on the display device as part of the likeness; highlighted to indicate the hyperlink; and selectable by a user to cause an operation associated with the second location; and
> apparatus from which the computer program is accessible by the computer system.

Dabney and Mason fail to teach the combination of elements in amended claim 1. MPEP § 2143.01 states: "The mere fact that references can be combined or modified does *not* render the resultant combination obvious unless the prior art also suggests the desirability of the combination." As stated in MPEP § 2142, "...The examiner bears the initial burden of

factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness..."

In fact, Dabney actually teaches away from the combination of elements in amended claim 1. For example, Dabney teaches away from a method ***performed by a computer system***, comprising:

> in response to content of a likeness of a hardcopy paper, ***detecting a reference*** at a first location within the ***content of the likeness***, the detected reference being associated with a second location, and ***wherein the detected reference is at least one of the following, other than a computer network address: an alphanumeric character; a symbol; a term; and a phrase***; and
>
> in response to the detected reference, ***embedding a hyperlink*** within the version between the first location and the second location, and the first location being: displayable on the display device as part of the likeness; highlighted to indicate the hyperlink; and selectable by a user to cause an operation associated with the second location.

Contrary to amended claim 1, Dabney teaches that a web editor ***manually*** operates pull-down menus for assigning a story or data record to a site/section. For example, in Fig. 13, Dabney shows a window 1300, which shows that a web editor operates pull-down menus 1310 and 1320 for assigning the story or data record to a "newssite.com:Metro" site/section (*see, e.g.*, col. 12, lines 15-20, and col. 14, lines 20-33).

Moreover, Dabney teaches away from a version of a hardcopy paper, the version being displayable on a display device as a likeness of the paper. Instead, in Fig. 14, Dabney shows a story (which is the data that was assigned to a particular site and section) in region 1440 of a webpage 1410 (*see, e.g.*, col. 14, lines 44-46). Notably, as shown in Fig. 14, Dabney's displayed webpage 1410 includes a pull-down menu, which: (a) does ***not*** exist in a hardcopy paper; and (b) consequently, teaches away from a likeness of the hardcopy paper.

Thus, in relation to amended claim 1, Dabney fails to teach, or even suggest, any basis for combining in a 35 U.S.C. § 103 rejection.

MPEP § 2142 states: "...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made...The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed

'as a whole.'" Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated.

In relation to amended claim 1, the motivation for advantageously combining the claimed elements would arise solely from hindsight based on Applicant's teachings in its own specification. Accordingly, the PTO's burden of factually supporting a prima facie conclusion of obviousness has not been met.

Thus, in view of the reasons stated herein, and for other reasons clearly apparent, the PTO has not met its burden of factually supporting a prima facie conclusion of obviousness in this case, and Applicant has no obligation to submit evidence of nonobviousness.

In relation to claims 6 and 11, Dabney is likewise defective in establishing a prima facie conclusion of obviousness.

Conclusion

For these reasons, and for other reasons clearly apparent, Applicant respectfully requests allowance of claims 1, 6 and 11.

Dependent claims 2, 4, 5 and 16-20 depend from and further limit claim 1 and therefore are allowable.

Dependent claims 7, 9, 10 and 21-25 depend from and further limit claim 6 and therefore are allowable.

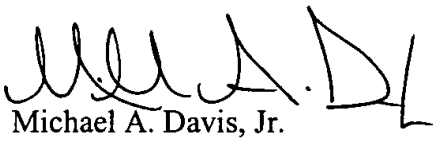
Dependent claims 12, 14, 15 and 26-30 depend from and further limit claim 11 and therefore are allowable.

An early formal notice of allowance of claims 1, 2, 4-7, 9-12, and 14-30 is requested.

To the extent that this Response to Office Action results in additional fees, the Commissioner is authorized to charge deposit account no. 08-1394.

Applicant has made an earnest attempt to place this case in condition for allowance. If any unresolved aspect remains, the Examiner is invited to call Applicant's attorney at the telephone number listed below.

Respectfully submitted,



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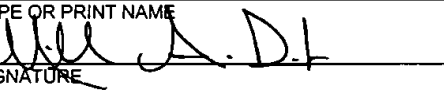

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